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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/477,082 12/30/99 KIDD

V 2427/IE988-U

EXAMINER

HM22/0314

HUNT, J ART UNIT	PAPER NUMBER
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DARBY & DARBY
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1642
DATE MAILED:

03/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/477,082

Applicant(s)

Kidd et al.

Examiner

Jennifer Hunt

Group Art Unit

1642



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-47 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-47 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9 and 26-29, drawn to methods of detecting inactivation of a CASP8 gene, and corresponding kits, classified in class 435, subclass 6.
 - II. Claims 10-20, drawn to a method of diagnosing or prognosing cancer, classified in class 435, subclass 64.
 - III. Claims 21-25 and 36-37, drawn to a nucleic acid sequence and corresponding expression vector, classified in class 536, subclass 23.1 and class 435, subclass 320.1.
 - IV. Claims 30-35, drawn to a method of treating cancer using gene therapy, classified in class 514, subclass 44.
 - V. Claim 38, drawn to a pharmaceutical composition, classified in class 514, subclass 44.
 - VI. Claims 39-47, drawn to a method of screening for a candidate compound and corresponding kit, classified in class 435, subclass 7.1.

2. The inventions are distinct, each from the other because of the following reasons:

The methods of Groups I, II, IV and VI are completely different methods, having different starting points, different method steps and different outcomes. The method of Group I uses measures polynucleotides and/or polypeptides to determine gene function. The method of Group

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II measures polynucleotides and/or polypeptides of specific types of cells to determine a diagnosis of or prognosis for cancer. The method of Group IV uses an expression vector to treat cancer. The method of Group VI uses a specific cell type to determine compounds which induce a specific type of apoptosis. These are distinct methods which are different for the reasons set forth above. All require non-coextensive searches and grounds of consideration.

The products of Groups III and V are completely different products, having different structural features and different biological functions. The compound of Group III is drawn to one of any number of genomic sequences, or sections thereof. The compound of Group V is drawn to a specific nucleic acid expression system, with a particular pharmaceutical activity. These are distinct products which are different for the reasons set forth above. They require non-coextensive searches and grounds of consideration.

3. Inventions of Groups V and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Group V can be used for a materially different process, such as to generate polypeptide in vitro.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for any

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one Group is not required for any other Group, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

If Group III is elected, applicant must further elect a single species of nucleic acid sequence from the sequences of SEQ ID NO's 1-10, and 12-28. Applicant is respectfully requested to further note what type of sequence the species is generic to (ie: intron, exon, promoter, etc.).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, group a of claim 21 is generic to groups b, and d-f, which are generic to group c.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Hunt, whose telephone number is (703) 308-7548. The examiner can normally be reached Monday through Thursday 6:30am to 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached at (703) 308-3995. The fax number for the group is (703) 305-3014 or (703) 308-4242.


Communications via internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [anthony.caputa@uspto.gov].

All internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists the possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist, whose telephone number is (703) 308-0196.

Jennifer Hunt

March 7, 2001


JENNIFER HUNT
PATENT EXAMINER
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